

S/N 10/736,027

Response to Office Action Dated 11/10/2004

REMARKS

Applicant respectfully requests allowance of the pending claims.
Claims 2-5, and 11-14 are pending in this application.

Claim Amendments

Claims 2-5, 11-14 were previously pending.

Amended claims: None.

Canceled claims: None.

No new claims are added.

Pending claims: 2-5, 11-14.

Request for Clarifications

The Applicant appreciates the Examiner's efforts and good will to bring this case forward to allowance.

The Office Action of November 10, 2004 has some flaws and Applicant requests clarifications. The Applicant does not wish to create prosecution estoppel by attempting to reply to flawed rejections.

First, the rejections under 35 USC § 103(a) (discussed below) were based on a combination of references that includes U.S. Patent No. 5,212,973 to van Staden et al. ("the van Staden reference" or "van Staden"). Specifically, both of the two rejection sections of the Office Action rely on the duplicated statement, "Van Staden et al teach a locking member 23 having a spiral curvature to encase a steering wheel rim" (page 2, section 2, of the Office Action). However, the van Staden reference does not include the term "locking member" as such and does not include a reference number "23." Rather than guessing at the Office's intended rejection, Applicant respectfully requests

S/N 10/736,027

Response to Office Action Dated 11/10/2004

clarification of which feature in the van Staden reference the Patent Office wishes to enter into the record of prosecution as evidence of obviousness under the statute.

Second, section 3 of the Office Action rejects claims 1, 6-10, and 15-20 under 35 USC § 103(a). However, these claims were previously canceled and are not currently pending. In other words, section 3 of the Office Action tries to reject canceled claims.

Third, section 2 of the Office Action states that "the method limitations of claims 12-14 are considered inherent to the use of the disclosed device." However, claims 12-14 are not method claims, nor do they include any method limitations.

Applicant's Recapitulation of Prosecution to Date

In the previous Office Action, allowable material was found and claims were deemed allowable if rewritten in independent form, including elements of the base and intervening claims, etc. The relevant claims were then rewritten and submitted to the Patent Office in the corresponding reply from the Applicant. Applicant now recapitulates elements of the prosecution in preparation for the possibility of appealing the case.

At the time of the Office's finding of allowable subject matter in the previous Office Action, the Office had cited an exhaustive list of more than 21 "gun rack" patent references, none of which included any teaching or suggestion of Applicant's patentable feature(s).

In the current Office Action, the Office presents a new obviousness rejection, by combining gun rack patent references with automotive patent references that describe steering wheel anti-theft devices, under the usual

S/N 10/736,027

Response to Office Action Dated 11/10/2004

obviousness standard, "it would have been obvious to one of ordinary skill in the art to modify one reference in light of the other."

In response to this unusual and surprising combination of gun rack and automotive references, Applicant wishes to point out that in this particular case, the Patent Office has established who one of ordinary skill in the art is, by providing the abovementioned fairly comprehensive list of 21 or more gun rack references and their corresponding inventors. "At the time the invention was made" and even for years before "the time the invention was made," many of these 21 inventors had access to at least some of the automotive anti-theft device references cited by the Office.

Even though many of these numerous inventors had access to the automotive references at the time Applicant's invention was made, and even prior to that time, it was not obvious to these gun rack inventors with their ordinary skill in the gun rack arts to modify / enhance their gun rack inventions in light of the automotive references now cited by the Office—or else one or more of these inventors would have made the enhancement. In other words, the Patent Office has established a strong evidentiary record of nonobviousness for Applicant's subject matter, because a fairly comprehensive list of those having ordinary skill in the art, provided by the Office, does not include anyone who included the automotive enhancement in their gun rack.

S/N 10/736,027

Response to Office Action Dated 11/10/2004

Rejection of the Claims**Rejections under 35 USC § 103(a)**

Claims 2-5 and 11-14 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,887,730 to St. George ("the St. George reference" or "St. George") in view of the van Staden reference.

As mentioned above, the aspect of van Staden that is being cited as evidence of obviousness is unclear, and clarification was requested above.

Also, as introduced above, by citing numerous (more than twenty-one) gun rack patent references, the Office has established a strong record identifying "one of ordinary skill in the art" including at the time of Applicant's invention. None of these twenty-one gun rack patent references, either alone or in combination, teach or suggest all the features of Applicant's secure gun display. Moreover, none of the twenty-one or more inventors—of ordinary skill in the art—found it obvious to enhance their gun rack inventions with features from the automotive references now cited by the Patent Office.

The van Staden reference teaches an automotive steering wheel anti-theft device intended to limit the degree of rotation of a steering wheel. Such an anti-theft device would not work, of course, incorporated as part of a gun rack. The automotive anti-theft device allows the steering wheel to which it is attached a great deal of motion, and relies on contact with the interior of the car to provide the anti-theft feature of limited steering wheel rotation. By itself (without the car interior to abut against) the van Staden device would not provide any anti-theft protection at all.

The spiral curved piece taught by van Staden for wrapping around a steering wheel would not work to secure a gun on a gun rack, because unmodified it would not fit around any part of a gun that would be advantageous for immobilizing the gun.

S/N 10/736,027

Response to Office Action Dated 11/10/2004

The van Staden curved piece might fit around a gun barrel, but such "barrel loops," are generally not by themselves feasible for securing a gun, as the barrel can be slid out of the barrel loop.

It is not a proper obviousness rejection to reject by modifying the spiral piece taught by van Staden into a shape suitable for securing a gun, and then combine the modified van Staden piece with a gun rack patent reference to obtain Applicant's subject matter. The motivation for modifying references and combining references must be found in the references themselves, not in the Applicant's specification (MPEP 2143.01). As described and illustrated in Applicant's specification and figures, Applicant's non-planar and/or helical curved piece follows the curve(s) of a human thumb and forefinger in trigger pulling position. Since a steering wheel does not have a trigger as a gun does, it would not be obvious to modify the van Staden curved piece to obtain a piece suitable for securing a gun in the manner defined by Applicant's claims.

Put another way, on most rifle style guns, the part of the gun held by the trigger pulling hand when it is about to pull the trigger has ubiquitously similar dimensions, because the shape and size of this part of guns is designed to accommodate human hands when they are in the trigger pulling position, regardless of a degree of physiological variation in the size of hands.

It so happens that this same part of a gun, which typically has fairly uniform dimensions across different guns, is also typically the optimal place for securing the gun—as this part of the gun, when secured, does not allow the gun to be easily disassembled.

It has not been obvious to those of ordinary skill in the art (as shown by the numerous gun rack references provided by the Office) to take advantage of the above property of guns to create an improved, secure gun rack. There is no motivation in St.

S/N 10/736,027

Response to Office Action Dated 11/10/2004

George and/or van Staden to combine the St. George reference with the van Staden reference, because the curved piece of the van Staden automotive steering wheel anti-theft device would itself require substantial modification not contemplated in its automotive setting to be of use as a "hand-in-trigger-pulling-position"-shaped piece in the gun rack art.

It should be noted that the currently pending claims were broadened from previous claim elements that described Applicant's curved piece in terms of the shape and curve of a "human thumb and forefinger (or human hand) in the trigger pulling position," that is, the claims were broadened to overcome an indefiniteness rejection by the Office.

Applicant now respectfully submits that the obviousness rejection of claims 2-5 and 11-14 should be removed and that these claims are in condition for allowance.

S/N 10/736,027

Response to Office Action Dated 11/10/2004

CONCLUSION

Applicant respectfully suggests that claims 2-5, and 11-14 are in condition for allowance and requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: 5-9-05

By: Mark C. Farrell
Lee & Hayes PLLC
Mark C. Farrell
Reg. No. 45,988
(509) 324-9256